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IN THE  
**Supreme Court of the United States**  
OCTOBER TERM, 1965

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No. 58

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EDWARD J. BRENNER, COMMISSIONER OF PATENTS,  
*Petitioner,*

v.

ANDREW JOHN MANSON, *Respondent.*

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**BRIEF, AMICUS CURIAE, FOR THE  
AMERICAN PATENT LAW ASSOCIATION  
IN SUPPORT OF THE RESPONDENT**

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**AUTHORITY TO FILE**

This *amicus* brief is presented to the Court under Rule 42(2). The letters of consent from petitioner and respondent are on file with the Clerk of the Court. Copies are included as Appendices F and G.

**INTEREST OF THE  
AMERICAN PATENT LAW ASSOCIATION**

The American Patent Law Association is an association of approximately 2800 members of the bars of many states interested in the laws relating to patents and allied subjects. This number represents approxi-

mately half of the patent lawyers in the country. We are vitally concerned that the patent law be applied in the public interest. We respectfully submit our views as a possible aid to this Court in deciding the important substantive issues raised by the present case.

However, we take no position and express no views as to the jurisdictional question presented by the Government's petition and brief.

We are especially moved to file this brief because this is the first case coming to this Court from the "patent side" of the United States Court of Customs and Patent Appeals.\*

We have no concern with, and express no views on, the private interests of the respondent in this case.

#### **THRESHOLD QUESTION OF IMPROVIDENT GRANT OF THE WRIT**

At the outset we raise the question of improvident grant of the writ. The substantive question as presented in the petitioner's brief differs from the substantive question as presented in the petition. Besides differing from each other, both differ from what the majority opinion in the court below characterized as the "single legal issue" (R. 63). So that the differences may be readily compared, the three are set forth below in side-by-side relations as follows:

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\*The United States Court of Customs and Patent Appeals (originally the United States Court of Customs Appeals) acquired by the Act of March 2, 1929 (Public—No. 914—70th Congress) both its present name and its jurisdiction over appeals in patent and trademark cases formerly vested in the then Court of Appeals of the District of Columbia.



(a)

[From the Government's Petition (p. 2)]  
Whether a process which produces a useless product is patentable.

(b)

[From the Government's Brief (p. 2)]  
Whether a process is "useful" within the meaning of the Patent Act (and hence patentable) merely because it operates to produce a product without any known specific utility.

(c)

[From the majority opinion in the C.C.P.A. (R. 63)]  
The single legal issue presented by this appeal is whether an applicant for a patent on a *new process* for making a *known compound* must establish a utility for such *compound*, in order to satisfy the requirements of Rule 204(b) preparatory to having an interference declared between his application and a prior patent.  
[Emphasis in the original]

This Court has not hesitated in the past to dismiss the writ as improvidently granted (*U.S. v. Rimer*, 220 U.S. 547 (1911); *Furness, Withy & Co. v. Yang-Tsze Ins. Assoc.*, 242 U.S. 430 (1917); *Layne & Bowler Corp. v. Western Well Works, Inc.*, 261 U.S. 387 (1923); *Keller v. Adams-Campbell Co., Inc.*, 264 U.S. 314 (1924); and *Rice v. Sioux City Memorial Park Cemetery*, 349 U.S. 70 (1955)) if, as the case develops, it appears that the original view as to its importance was erroneous—even where, as here, the Government is the petitioner (*Rimer*), or where the Court was initially "mistaken in assuming that an important issue under general patent law was involved" (*Keller*); and even after previous argument and decision by the Court (*Rice*). See also *General Talking Pictures Corp. v. Western Electric Co.*, 304 U.S. 175, 179 (1938):

"Petitioner is not here entitled to decision on any question other than those formally presented by its petition for the writ."

We are not unmindful of Rules 23(1)(c) and 40(d) (2), but it is suggested that a subsidiary question "fairly comprised" within the question *actually* pre-

sented may become so narrow as to call for the application of the doctrine of the cases cited above.

The difference in scope between the "useless product" of question (a) and the "product without any known specific utility" of question (b) is very significant, and might well bring into operation the doctrine of *Rimer* and *Keller*. In any event, questions (a) and (b) are markedly different from, and broader than, the issue said by the majority of the court below to be the "single legal issue".

Moreover, as will be pointed out in greater detail hereinafter, the petitioner's brief (p. 5) concedes that the Ringold and Rosenkranz publication (R. 59-61) indicates a use for the relatively small class of organic chemical compounds, technically known as 2-methyl-dihydrotestosterones, of which the products of the process involved herein are members. Since that publication is dated "November 1956" (R. 59) which is slightly over a year earlier than the patentee's filing date (R. 57) and even slightly earlier than the patentee's Mexican Convention date of December 17, 1956 (R. 57), it follows that, under the doctrine of *Carnegie Steel Co. v. Cambria Iron Co.*, 185 U.S. 403 (1902),\* the respondent was entitled to rely upon that earlier disclosure of utility to satisfy even the most stringent requirements of the Government under 35 U.S.C. § 101. It follows for this additional reason that this Court may well conclude that the writ was improvidently granted.

Nevertheless, the Association wishes to present its views as to each of questions (a) and (b) as of possible interest to the Court.

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\* "That which is common and well known is as if it were written out in the patent . . . ." [p. 437]

## ARGUMENT RE UTILITY

The substantive issue set forth in the second question presented on page 2 of the Commissioner's petition is as follows:

"2. Whether a process which produces a useless product is patentable."

That question squarely presents for decision just what is meant by the adjective "useful" in 35 U.S.C. § 101.

The position of *amicus* is that the adjective "useful" has a very broad meaning, broad enough to include within its scope the present factual situation where the petitioner admits that the process defined by respondent's process claims is adequately disclosed, even though, *arguendo*, the product is assumed to be useless.

We say *arguendo* advisedly, because it seems that the real issue\* involved in this case is not as stated in the petition. Reference to the printed "Brief for the Commissioner of Patents" in the court below reveals the following statements relative to the issue presented to that court *by the Patent Office*:

"Hence, the sole issue before this Court [of Customs and Patent Appeals] in this appeal is whether the finding of insufficiency under the facts of this case, was or was not proper." [page 4]

"The decision of the Board [of Appeals in the Patent Office] indicates that the issue presented

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\* A review of the record shows that the substantive issue as framed in the Government's petition to this Court made its appearance *for the first time* in the second paragraph of the *dissenting* opinion by Chief Judge Worley in the court below. See 333 F. 2d at 239. (R. 71)

is whether the affidavits are sufficient with respect to the showing relative to the utility of the compounds produced by the process of claims . . .” [page 5]

“It is submitted that the sole issue is whether the affidavit filed Aug. 7, 1962 . . . under [Patent Office] Rule 204(b) eliminates the deficiency of the prior affidavits, and whether the decision of this Court in *In re Dickinson et al*, 133 USPQ 39 [299 F. 2d 954 (1962)] is controlling on that issue.” [page 5]

It thus rather clearly appears that the case reaches this Court on a substantive issue different from, and broader than, the issue or theory on which it was presented below.

Moreover, that issue seems to be framed in the form of a “loaded” question. It assumes that which is by no means conceded, namely, that a chemical compound is useless, or as it is perhaps more frequently expressed in patent jargon, “has no utility”. It is of course conceded that many compounds have no *commercial* utility, but that is not equivalent to saying that they have no utility *within the meaning of the patent law*.

The case of *aluminum* may be cited as somewhat in point. Aluminum was known as a substantially pure metal for some decades prior to Hall’s discovery of the electrolytic method employing molten cryolite as electrolyte for recovering the metal from bauxite in a really practicable manner. Prior to Hall’s discovery aluminum was hardly more than a laboratory curiosity, obtainable only at such expense and with so much difficulty that its cost was comparable to that of the

precious metals. This Court may take judicial notice\* of the more recent role of aluminum on a large scale in machines, building construction, packaging, aircraft, etc. etc.

The petition for the writ also attempts to raise the spectre of "patent monopolies" or "monopoly" (page 10 of the petition) *although no such issue was presented by the Patent Office to the court below.*

This apparent preoccupation with the phantom issue of monopoly\*\* purports to be supported by or based in part on the following reasoning in the petition for the writ (page 10):

*"The development of a process for making a use-less product adds nothing to the sum of useful knowledge. All that it does is, first, to enable the developer to block further research into the use of the product or to confine it to those whom he authorizes . . . [Emphasis added]*

The italicized portion is respectfully submitted to be completely wrong as a matter of law. This Court at

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\* *Werk et al v. Parker et al*, 249 U.S. 130 (1919), and cases there cited.

\*\* As to whether and to what extent a patent is a monopoly, see the illuminating article by Giles S. Rich (now Associate Judge of the United States Court of Customs and Patent Appeals) entitled "The Relation Between Patent Practices and the Anti-Monopoly Laws": in 24 Jour. Pat. Off. Soc., 85-106 and 159-181 (1942). See also Judge Giles Rich's Kettering Award Address of 1964, entitled "The Vague Concept of 'Invention' as Replaced by Sec. 103 of the 1952 Patent Act", reproduced as Appendix A to the University of Texas Law School's Brief Amicus Curiae in Support of 35 USC 103, in the case of *William T. Graham and Graham Plow Inc. v. John Deere Company of Kansas City and Deere & Company*, No. 11 now pending in this Court. Pages 3a-5a are of especial interest.

least as early as 1876, in *Merrill v. Youmans*, 94 U.S. 568, 574, made it crystal clear that a *process* claim in a patent covers the process only, and gives no protection to the resulting product.

It is therefore inaccurate to say that a patent on the *process* could enable the patentee to "block further research into the use of the *product*". Or, as stated elsewhere in the petition (p. 11):

"The rule adopted by the court below necessarily closes the door to *experimentation* with the same or similar processes by persons other than the patentee or those he authorizes" [Emphasis added]

Although experimental use coupled with commercial activity may constitute infringement (*Spray Refrigeration Co., Inc. v. Sea Spray Fishing, Inc.*, 322 F. 2d 34 (CA 9, 1963)), the weight of authority is that experimental use alone does not constitute infringement. This has been held as recently as 1958 (*Chesterfield v. U. S.*, 159 F. Supp. 371 (Ct. Cls., 1958)) and as far back as 1813—see Circuit Justice Story's opinions in *Whittemore v. Cutter*, F.C. No. 17,600 (C.C.D. Mass., 1813) and in *Sawin et al. v. Guild*, F.C. No. 12,391 (C.C.D. Mass., 1813). *Poppenhusen v. Falke et al.*, F.C. No. 11,279 (C.C.S.D. N.Y., 1861), and *Kaz Mfg. Co., Inc. v. Chesebrough-Ponds, Inc.*, 317 F. 2d 679 (CA 2, 1963), are also of interest, as well as 69 *Corpus Juris Secundum*, pp. 845-6 and 849.

To return to the broad question of usefulness or utility in the law of patents, this has been obscured, so far as the decided cases are concerned, by a recurrent looseness of language from which it appears upon study that what the court really meant by usefulness

or utility was something quite different from the issue with which we are concerned in the present case. Thus, in the very early cases in the lower Federal courts where usefulness or utility is referred to in any real depth, the context\* makes it clear that what was really under discussion was what we today would call operativeness\*\*, or degree of novelty over the prior art, or commercial success or acceptance, or practicality.\*\*\* The same thing, strangely enough, seems to be true of previous opinions of this Court. Before citing the prior cases in this Court where usefulness or utility is discussed in a more than passing manner, attention is invited to Appendix A where, for convenience, the Constitutional provision (Article I, Section 8, Clause 8) as well as all of the pertinent statutory language (from the first Patent Act of April 10, 1790 down to the present Act) is collected. This appendix shows that the statutory language involved in this case has not changed significantly from 1787 down to the present language of 35 USC § 101.\*\*\*\*

The earliest detailed discussion of utility or usefulness to be found in the U. S. Supreme Court reports

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\* The most important of those found in the old Federal Cases are collected and excerpted in Appendix B.

\*\* A good example of such a case is *Ex parte De Bausset*, 1888 C.D. 66, a decision by Commissioner Hall.

\*\*\* A particularly apperceptive approach in a case of this kind involving the idea of preventing canals from being closed over by ice in the wintertime by heating them with steam pipes, is represented by Commissioner Fisher's opinion in *Ex parte Robert A. Chesebrough*, 1869 C.D. 18, which is likewise remarkable for its brevity.

\*\*\*\* In his "Commentary on the New Patent Act", 35 U.S.C.A. 1 at 36, Mr. P. J. Federico pointed out that "[u]sefulness, usually referred to as utility, is a requirement under section 101."

is found in the Appendix of 3 Wheat. (16 U.S.) for the February 1818 term, beginning at page 13 and extending to page 29.\* This takes the form of a Note on the Patent Laws by Justice Story.\*\* Justice Story first discussed English law, and at page 16 observed that,

“7. The invention must not only be new, but useful; for if it be contrary to law, or mischievous, or hurtful to trade, or generally inconvenient, it is, by the terms of the statute, void. 3 Inst. 184.”

Later, on page 24, in discussing American law on the subject Justice Story noted that,

“By *useful* invention, in the patent act, is meant an invention which may be applied to a beneficial use in society, in contradistinction to an invention injurious to the morals, health, or good order of society, or frivolous and insignificant. *Bedford v. Hunt*, 1 Mason’s R. *Lowell v. Lewis*, 1 Mason’s R. It is not necessary to establish that it is in all cases superior to the modes now in use for the same purpose.”

With Justice Story’s comments as a starting point, we may then proceed to the following cases decided by this Court where usefulness or utility is referred to in a more than casual or passing manner:

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\* Now reproduced in *Deller’s Walker on Patents*, Second Edition, 1964, Vol. 1, pages 574-589.

\*\* In a brief biographical note appearing at 30 Fed. Cas., page 1395, Justice Story is said to have “had great influence upon the development of American admiralty, prize and patent law.” On the scholarly attributes of Justice Story in general, see the “Proceedings of Court Had Upon the Death of Judge Story” at 11 L. Ed. (4 How.) 846-7, and the somewhat lengthier memorial notice at 30 Fed. Cas., pages 1335-41.



*Seymour v. Osborne*, 11 Wall. (78 U.S.) 516 (1870), Reaping machine.

*Densmore v. Scofield*, 102 U.S. 375 (1880). Oil-tank car for carrying petroleum and other like substances in bulk.

*McClain v. Ortmyer*, 141 U.S. 419 (1891). Pad for horse-collars.

*Gandy v. Main Belting Company*, 143 U.S. 587 (1892). Belt or band for driving machinery.

*Grant v. Walter*, 148 U.S. 547 (1893). Reeling and winding silk and other thread.

*DuBois v. Kirk*, 158 U.S. 58 (1895). Movable dams.

*Diamond Rubber Company v. Consolidated Rubber Tire Company*, 220 U.S. 428 (1911). Rubber tires for vehicle-wheels.

*Beidler v. U.S.*, 253 U.S. 447 (1920). Photographing and developing apparatus.

*Corona Cord Tire Company v. Dovan Chemical Corporation*, 276 U.S. 358 (1928). Vulcanization of rubber.

Excerpts from these Supreme Court cases are collected in Appendix C to this brief.

Reference may also be made in passing to an interesting article by Judge Giles S. Rich entitled "Principles of Patentability", 28 Geo. Wash. L. Rev. 393-407 (1960), especially pp. 399-400.

Since so far as we can discover in the prior decisions of this Court there is no direct authority on the broad issue presented by this case, it follows that in in-

interpreting the intent of the framers of the Constitution and of the first and succeeding patent statutes this Court is free to decide the question in accordance with the broadest possible public policy.

The Government's petition takes the position that "[t]he development of a process for making a useless product adds nothing to the sum of useful knowledge." This seemingly presupposes some justification for thinking that the founding fathers of our country intended to place the acquisition of useful knowledge, i.e., useful *scientifically*, beyond the pale of the useful arts. But the question may be asked, why should "useful" in this context *exclude* that which increases our knowledge of science\* and include *only* that from which one may possibly realize some financial return some time in the near future? Such a narrow and forced construction of the term "useful" seems hardly consonant with the tremendous sums expended by the Federal government\*\* nowadays to foster research and discovery, both pure and applied.

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\* As a matter of fact, even reports of negative results (e.g., of activity in the steriod field) are important. A new compound intended to be immediately screened with the idea of "blocking" blind leads as rapidly as possible so as to enable researchers to proceed with other and more fruitful leads is useful. Therefore, an economical and feasible method for the production of compounds for research purposes is assuredly a "useful art".

\*\* In the lead article of a recent (July, 1965) issue of *Scientific American*, entitled "The Support of Science in the U.S.", pages 19 et seq., by Dael Wolfe, shown on page 16 to be executive officer of the American Association for the Advancement of Science and publisher of the association's official magazine *Science*, we find the following significant passages:

"This year in the U. S. nearly \$21 billion—3.2 percent of the gross national product—will be spent for research and develop-

Moreover, considering the question on a historical basis, can anyone familiar with the life and works of Benjamin Franklin,\* the elder statesman of the Constitutional Convention, that amazing inventive genius and pioneer scientist of our Colonial period who, like

ment. Some two-thirds of the funds will be supplied by the Federal Government." [p. 19]

"Meanwhile the economy of the country has gained enormously from the upsurge in technological research and development. In 1953 research and development accounted for 11 percent of all industrial investment; in 1962 research and development absorbed about 25 percent." [p. 20]

"In the 12 years from 1953 to 1965 every major source of research and development funds increased its support substantially. Federal funds are five times what they were in 1953. Industrial support has tripled, and the universities have done almost as well. The other nonprofit institutions are contributing six times their 1953 amount." [p. 21]

In a book review in *Science* for 25 June 1965, at p. 1707, we find a [Swedish] sociologist beginning his review by stating as follows:

"The Soviet Union openly and repeatedly proclaims that its goal is to become the world leader in all key branches of basic and applied research. China has the same goal. Each of them aims to displace the United States from what one Congressman recently called its 'unquestioned world leadership' in scientific and technological research. Both the Soviet Union and China are cheering themselves on in this research race with the Marxist dictum that the capitalist nature of society in the United States will throttle the growth of its science and technology."

\* "His [Franklin's] faith in scientific progress never wavered. When confronted with skepticism about the utility of the lighter-than-air balloon flown in Paris in 1783, he replied 'Of what use is a new-born babe?'" Quoted from Ralph L. Ketcham, "Benjamin Franklin", page 110 (The Great American Thinkers Series, Washington Square Press, 1965). And see Edwin Hubble, "The Nature of Science", Huntingdon Library, 1954, page 27, where a similar allusion is given, together with Faraday's famous reply to a broadly similar question: "Some day you may be able to tax it."

the fabled Prometheus of old, called down the very lightnings from the heavens—that thinker who devoted much of a long and fruitful lifetime to what we today would call scientific research; can anyone *seriously* believe that such a man would countenance for one moment any interpretation of the patent statutes that would tend in the slightest way to discourage man in his ceaseless search for knowledge that will enable him to push back the frontiers between him and the still undiscovered mysteries of nature?

The petition for the writ suggests that the problem is of especial importance in the drug industry. It is said that one who has invented nothing useful should not be put in the position to discourage, if not control,\* segments of important areas of medical or pharmaceutical research. This ignores the basic facts of industrial life. Patents, whether valid or invalid, do not discourage research—indeed, by their very nature they cannot! By their disclosures they effectively *promote* research. In view of the tremendous mushrooming of research in recent decades, especially in the very field emphasized in the petition, only a Rip van Winkle could suppose that the issuance of patents had done anything to restrain the tempo of such research.\*\* The issuance of a patent for process A for the production of a given compound acts through its potential restraint as a deciding incentive to competi-

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\* The petitioner does not enlighten us as to how the owner of a patent on something that is not useful could possibly *discourage* any area of research, let alone control it! Besides, that is not the question here in any event for a patent *already* exists on the process—the only question is whether the invention was first made by respondent rather than by Ringold and Rosenkranz (R. 57).

\*\* Cf. the statistics given by Dael Wolfe, *supra*.

tors of the patent owner to engage in independent research to develop rival or equivalent processes B, C, D, etc. to achieve the same or similar—and sometimes even superior—results, with the consequent overall enrichment of the sum total of man's knowledge of nature—and incidentally increasing competition and decreasing the possibility of "monopoly". We thus see that the Government's fear is really only a figment of the imagination. The supposed "injury to the public welfare" (petition, page 11) never materializes; the net result is quite the contrary.

At this point it would not be amiss to mention the admonition by this Court in *Mazer v. Stein*, 347 U.S. 201 (1954):

"The economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts'. Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered." [p. 219]

The petition points out (bottom of page 10) that "[f]requently processes for producing complex compounds are developed even though the compound has no known use". This would certainly seem to be a very good thing. Such practice thereby makes available to other chemical researchers an even wider array of compounds available for screening and testing for new uses not remotely envisaged by the chemist who developed the initial process in question. It, in effect, provides still another "tool" that might prove useful

to (say) a clinician groping about to find a remedy for one of the diseases that afflict mankind. It is of course axiomatic that a clinician cannot try out a compound that is not available to him.

The petition states (top of page 11) that "[s]ubsequent experimentation may show that the compound is a very valuable drug." All well and good. In that case, the subsequent experimenter would have it within his power to apply for and possibly obtain a patent covering his later-discovered process for the therapeutic use or for the novel therapeutic composition containing it. But this would be a second and independent invention.

Since the Government's petition particularly emphasized the importance of the problem involved in this case "in the drug industry" (petition, page 10), it is suggested that an address of several years ago entitled "Patents and the Conquest of Disease", by John T. Connor, then President of Merck & Co., Inc. and now Secretary of Commerce, is of transcendent importance and may prove to be of interest to the Court. This is regarded as of sufficient interest to justify incorporating it as Appendix D to this brief for the possibly greater convenience of the Court, since extracting excerpts from it would not impart its true flavor or do it full justice. For like reasons, we have incorporated as Appendix E a recent statement by Walter A. Munns, President of Smith Kline & French Laboratories, before the Senate Subcommittee on Patents, Trademarks, and Copyrights.

Many years ago, while on circuit, Justice Story said that "[t]he doctrine of patents may truly be said

to constitute the metaphysics\* of the law." *Barrett et al. v. Hall et al.*, Fed. Case No. 1047 (C.C. Mass., 1818). Metaphysics or not, there is no need or excuse for so construing the patent law—at least in the absence of a clearly expressed Congressional intent to the contrary—in such fashion as to remove the incentive to develop *and promptly disclose* new processes for producing products, without necessarily waiting for the products to be tested.\*\*

What stranger contrast in attitudes could we have than, on the one hand, the expenditures of tremendous sums of money by certain departments of the Federal Government to enable us to be the first to achieve the technical feat of placing a man on the moon, and on the other hand, the efforts of the Government in espousing an interpretation as strict as possible on the otherwise broad term "useful" in the Constitution and the patent statutes so as necessarily to *discourage* rather than encourage the expenditure of time and money on scientific and industrial research and development?

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\* And to the same effect more recently, see Dr. Nathan Reingold, Science Bibliographer in the Science and Technology Division of the Library of Congress, in *Technology and Culture*, Vol. I, No. 2, page 166 (Spring, 1960).

\*\* Note here the incentive for *prompt* disclosure to the public. Why should the inventor of the *process* be required to make a *second* invention (some particular use for the product of the process) before being regarded as entitled to secure a patent on his *first* invention? This would only lead to more delay in disclosing the invention to the public, which *per se* is undesirable. After all, one must not lose sight of the fact that the inherent nature of a *process* is that it produces a *product*. This is the *only possible utility* that any process can have. A process is therefore in and of itself *necessarily* useful within the meaning of 35 U. S. C. § 101.



What the Patent Office has for some time been attempting to do, and is still doing,\* as should be clear from a comparison of the Government's position here with the prior case law reviewed in Appendices B and C, is to *change* the law on utility with respect to patents on process inventions. There is no clear or valid reason for such a change in policy, and the Court of Customs and Patent Appeals very properly refused to sanction it.

#### THE QUESTION OF UTILITY AS PRESENTED IN PETITIONER'S BRIEF AS DISTINGUISHED FROM THE PETITION

In the Government's *petition* a "useless product" is referred to in the question presented (p. 2). In the Government's *brief*, however, the product is referred to in the question presented (p. 2) as "a product without any known specific utility". As pointed out earlier in this brief, there is a wide difference in scope between these two questions, thereby fully justifying this Court in concluding that the writ was improvidently granted.

Apart from that, however, this *amicus* respectfully submits that the record wholly fails to support the Government's contention that the product of the process was "without any known specific utility".

The Government's brief admits (p. 5) that the November 1956 publication by Ringold and Rosenkranz

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\* In *Ex parte Joly et al.*, Appeal No. 7472, argued before the Court of Customs and Patent Appeals on October 8, 1965, the Patent Office Board of Appeals expressly refused to follow the decisions of the Court of Customs and Patent Appeals, its statutory appellate court (cf. 28 U.S.C. § 1542 and 35 U.S.C. §§ 141-4), on the issue of process claim utility, and on that point is making essentially the same contentions as it is making in the present case.



(R. 59-61) indicates a use for the small class of 2-methyl-dihydrotestosterones. The 2 $\alpha$ , 17 $\alpha$ -dimethyl derivative of the respondent's rejected process claim 2 (R. 62) is a member of that small class. In rejected process claim 3 the 17-substituent is "lower alkyl" which of course includes the one-carbon-atom methyl group (R. 5, last paragraph). The 2 $\alpha$ ,17 $\alpha$ -dimethyl-androstan-17 $\beta$ -ol-3-one of rejected claim 2 (R. 62) is shown structurally at R. 60, right column, second structural formula, when the IIb substitutions are made, i.e., Me (methyl) for R, and H (hydrogen) for R'. See R. 60, left column, last compound specifically named in the first full paragraph. At R. 61, left column, first full paragraph, Ringold and Rosenkranz suggest a definite use as a part of the published prior art available not only over 3 years before respondent filed (R. 3) but even more than 12 months before Ringold and Rosenkranz filed (R. 57). Respondent is fully entitled to rely upon that prior art indication of use as a tumor inhibitor (to paraphrase slightly the petitioner's brief at page 5) in view of this Court's holding in *Carnegie Steel Co. v. Cambria Iron Co.*, supra.

The fact that the Ringold and Rosenkranz article suggests (R. 61) that the program of screening for anti-tumor effectiveness was still in progress at the time of publication of the article is immaterial. Any objection to that, if objection there be, was very fully answered by this Court long ago in *The Telephone Cases*, 126 U.S. 1 at 535-7 (1888).

**"THE SINGLE LEGAL ISSUE" REFERRED TO IN THE  
MAJORITY OPINION OF THE C.C.P.A.**

That issue (R. 63) is a very specific one obviously quite different from either of the two "questions presented" by the Government in its petition and brief respectively. Probably little should be said here concerning it, in view of the present posture of the case.

Suffice it to say that the real issue is not whether a patent should be granted on the process in question—one has already been granted to Ringold and Rosenkranz—but is whether Ringold and Rosenkranz are or respondent Manson is entitled to be recognized as the first inventor(s). But the patent statute entrusts the determination of *that* issue (priority of invention) to a different tribunal in the Patent Office, namely, the Board of Patent Interferences (35 U.S.C. § 135). Here, the proceedings were *ex parte* before the Primary Examiner and the Board of Appeals (35 U.S.C. § 134). As is well recognized (cf. *In re Nelson et al.*, 280 F. 2d 172, 187 (1960)), different policy considerations may be involved in *ex parte* and *inter partes* cases. In the former a pure question of patentability under the statute is involved; in the latter it is the question of which of two rival inventors has the paramount right to a patent on an invention that has already been determined by the Patent Office to be a patentable one. All that respondent is required to do *ex parte* to qualify for the requested interference is to establish *prima facie* his right to an award of priority, under Patent Office Rule 204(b) reproduced at p. 4 of petitioner's brief. This he has done by means of the five affidavits submitted under that rule (R. 9, R. 10-18, R. 33, R. 46 and R. 47-48). The interference should

be declared with the Board of Patent Interferences then determining the issue of priority of invention in the customary manner. See *In re Dickinson et al.*, 299 F. 2d 954 (1962).

#### COMMENTS ON VARIOUS MISCELLANEOUS POINTS MENTIONED IN THE GOVERNMENT'S BRIEF

*P. 18, lines 2-4*—A use was in fact shown in the November 1956 Ringold and Rosenkranz article. Apart from that fact, *admitted on page 5 of the Government's brief*, the footnote reference to *Petrocarbon Ltd. v. Watson*, 247 F. 2d 800 (1957), at that point in the brief suggests at least one possible source of confusion. It is well recognized that the requirements as to sufficiency of disclosure under 35 U.S.C. § 101 and under 35 U.S.C. § 112 are by no means necessarily the same. *In re Folkers et al.*, 344 F. 2d 970 (May 6, 1965). *In re Krazinski et al.*, 347 F. 2d 656 (June 24, 1965). *In re Isaacs et al.*, 347 F. 2d 887 (July 1, 1965). The present case was decided in the court below by reference to 35 U.S.C. § 101 (R. 64-67), the majority opinion carefully distinguishing a 35 U.S.C. § 112 situation. (R. 68). *Petrocarbon*, on the other hand, shows on its face that it was decided on the basis of 35 U.S.C. § 112. Long ago this Court pointed out that a judicial opinion cannot be relied upon as a binding authority unless the case was such as to call for its expression. *Carroll v. The Lessee of Carroll et al.*, 16 How. (57 U.S.) 275 at 287 (1853).

*P. 19, lines 14-19*—these passages are inconsistent with the admission made by the petitioner at p. 5 of its brief, as well as contrary to what is actually taught in the November 1956 Ringold article.

*P. 20, footnote 15*—the apparently unfounded amplification of the definition of “science” at this point vis-a-vis copyrights— a few lines thereafter being distinguished from “useful arts” vis-a-vis patents but here modified to mean “knowledge in general”—seems wholly inconsistent with the Government’s quotation from the *Great Atlantic & Pacific Tea* case about the middle of page 24 of the brief.

*Pp. 20-21 footnote 16*—it could hardly be seriously suggested by the Government that even as of 1785, an instrument for fixing latitudes would lack the necessary utility to satisfy present-day 35 U.S.C. § 101. Not even a landlubber would be likely to hold such a view—especially if at the time he happened to be lost in the vast reaches of (say) the South Atlantic Ocean without instruments for navigation. The problem of fixing latitudes, and the (historically) still more difficult problem of determining longitudes, has always been of the most intensely practical kind. In “Royal Society, Its Origins and Founders”, Sir Harold Hartley, Editor, 1960, the work of the 17th-century scientist, Laurence Rooke, on the problem of determining longitude at sea, is referred to at p. 116 as “of course, of vital economic importance”. The problem was not satisfactorily solved until the work of John Harrison shortly after the middle of the 18th century—see Samuel Smiles, “Men of Invention and Industry”, 1855, pp. 72-104, where Harrison is said to have “conferred an incalculable benefit on science and navigation, and established his claim to be regarded as one of the greatest benefactors of mankind.” Smiles refers to problems involved in both latitude (pp. 83-84) and longitude determination. See also T. K. Derry & T. I. Williams, “A Short History of Technology”,

Oxford University Press, 1961, pages 205, 206, 210, 211. In Beckmann's "History of Inventions", Fourth (1846) Edition, Vol. I, page 371, we are told that not many years after Philip III of Spain offered a tremendous sum as a reward to anyone who should discover the means of finding the longitude of a ship at sea, Morin about 1630 is reported to have said to the Cardinal Richelieu, "Id vero an ipsi daemioni nescio, homini autem suscipere scio esse stultissimum" ("I know not what such an undertaking would be even to the devil himself, but to man it would, undoubtedly, be the height of folly.").\*

Of course, whether Michael Byrne's "new invented Instrument" was *operative* for its intended purpose would be quite another matter; one having nothing to do with whether its utility had been sufficiently indicated by its inventor, and therefore nothing to do with the present case.

As a practical matter, there is no harm in granting patents on truly useless inventions in the commercial sense. One of the beauties of the patent system is the automatic adjustment of the value of the patent monopoly to the value of the contribution. Just as one does not expect all books or plays given copyright protection to be edifying or best sellers or for all "music" protected by copyright to be either aesthetically pleasing or "hits", so may one not reasonably expect every invention to supersede all other like inventions. It is enough if it is not frivolous, immoral or mischievous, which is the old reliable test suggested by Justice Story.

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\* One wonders whether official attitudes toward innovation have changed much in three hundred years.

It is *not each individual invention* that must be capable of promoting progress in an art to be patentable—any more than in copyright—but the true meaning of the Constitution is that the patent *system* is to be so devised by Congress as to carry out the intent of promoting the useful arts. This Congress has done, changing the system from time to time and, on the basis of some 175 years experience, has now *itself* stated expressly *all* of the prerequisites to patentability. “Useful” was continued in the law in the light of the Justice Story interpretation. It should not at this late date be changed so as supposedly to conform to what some theorists might feel *should* be the law.

*P. 28, lines 9-14*—as has been shown above, there is no basis in the record of this case for the reference to “presently useless processes”. The process is useful for the only purpose to which any process can ever be put, namely, the production of a product. Moreover, the Government has not explained how a patent on a presently useless process, if such there be, can stifle progress. If there is indeed a useless process, who would use it?

*P. 29, lines 1-2*—Ringold’s disclosures are both *prior*, not subsequent, to the filing date of respondent’s *application*. What precise time relationship they bear to respondent’s *actual* process can only be adequately determined during an interference proceeding under 35 U.S.C. § 135.

*P. 29, last three lines*—the product *does* have sufficient utility to warrant a patent on the process. Ringold and Rosenkranz already have the patent (R. 57).

*P. 30, lines 16-21*—how can the Patent Office or the courts realistically determine “the potential harmful economic consequences” here referred to? See the addresses by John T. Connor, President of Merck & Co. and now Secretary of Commerce, and Walter A. Munns, President of Smith Kline & French Laboratories, set forth hereinafter in Appendices D and E.

The Government’s approach seems to be tantamount to saying that only *good* books, *pleasant* music, *aesthetically pleasing* pictures, and *edifying uplifting* speeches and sermons shall be subject to copyright. Justice Holmes, speaking for this Court, laid that notion to rest over 60 years ago in *Bleistein v. Donaldson Lithographing Company*, 188 U.S. 239, 251 (1903).

It would seem to be much safer in the case of patents to adopt the time-tested approach of Justice Story that whether the invention

“be more or less useful is a circumstance very material to the interests of the patentee, but of no importance to the public. If it be not extensively useful, *it will silently sink into contempt and disregard.*” *Lowell v. Lewis*, Fed. Cas. No. 8568 (C.C.D. Mass., 1817)

*P. 31, lines 7-11*—the Government has not shown how a patent on a new *process* could possibly operate to “close the door to experimentation or innovation” by others with the *product*. The argument earlier in this brief has shown quite the contrary.

*P. 31, lines 17-18*—these two lines completely misconceive the effect and operation of a process patent. Such a patent, on the contrary, would serve to *stimulate* competitors to try to find a different route to the



product. As a practical matter, however, a patent owner having the predatory instincts seemingly suggested in the Government's petition and brief would hardly be likely to waste his time trying to foreclose his competitors from practicing a process leading to the production of a "useless" product.

*P. 31, lines 19-25*—there seems to be no basis in the record for this assertion. It can hardly be said that respondent is a "preferred" inventor, to date at least. Even if respondent wins the present appeal, he still must surmount the hurdle of the interference priority contest that would then ensue.

*P. 32, line 10*—the reference to "useless patents" seems unwarranted in view of the fact that Ringold and Rosenkranz already have a patent on the process in question.

*P. 32, last five lines*—the fallacy of the argument as regards foreclosing research and innovation by others in this area has already been demonstrated. The reference to Ringold as the "first inventor" seems unwarranted, since that is the very thing yet to be established—the very purpose of the attempt by respondent to provoke an interference. The Government therefore assumes that which has yet to be proven.

*P. 33, lines 3-5*—it is the unduly restrictive view of the function of the patent system that will the more surely stifle scientific development, innovation and competition. Encouragement, not stifling, is what is wanted. This strictly *patent* case ought not to be confused with some kind of proceeding under the anti-trust laws.

*P. 34, lines 5-9*—the basis in the record for this statement is not apparent. All respondent has to do



is make out a *prima facie* showing of invention prior to the effective date of the Ringold and Rosenkranz patent. To that end, and especially so far as provoking the desired interference is concerned, respondent is fully entitled to rely upon a prior art publication to establish that the utility of the product of the process was already known to those skilled in the art. That the prior art publication in question happened also to be that of Ringold and Rosenkranz is interesting but immaterial as a matter of law.

### CONCLUSION

The writ of certiorari should be dismissed as improvidently granted. On the merits, the judgment of the Court of Customs and Patent Appeals was eminently correct and should be affirmed.

Respectfully submitted,

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